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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,407	08/27/2001	Hideki Noma	450108-02924	4158

20999 7590 02/25/2005

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NEW YORK, NY 10151

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,407

Applicant(s)

NOMA, HIDEKI

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 51-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-27-01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group One (I), claims 1-50 in the reply filed on January 10, 2005 is acknowledged.

Claims 51-81 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 10, 2005.

Applicants are respectfully requested to cancel the non-elected claims in response to the Office Action.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on August 27, 2001 is being considered by the examiner. However, Japan Application Nos. 1-1-3740 and 11-188678 are not being considered because there were no English translation. In addition, Japan Application No. 11-126017 is not being considered because there was no copy provided.

Drawings

The drawings filed on August 27, 2001 has been acceptable.

Claim Objections

Claim 30 are objected to because of the following informalities:

"said virtual creature" should be --said robotic device--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-25 and 46-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because the program product should recite instructions or code for performing the steps rather than the steps themselves.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-25 and 46-50 are rejected under 35 U.S.C. 101 because it fails to recite ***computer program*** instructions stored in a medium. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-50 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,260,750 to Barad et al.

Regarding claims 1, 6, 11, 16, and 21, Barad discloses a system, method, device, and computer program for purchasing or receiving an order for a virtual creature (personalized toy) existing as a software and programmed to act or more, comprising: first communication means provided on the order sender side (accessing a computer in 110 is performed by customer 60) of the virtual creature (collecting orders, col. 5, lines 50-61, Figure 5); second communication means provided on the order receiving side of the virtual creature (processing ordering, col. 5, lines 50-51; col. 6, lines 52-61, Figure 5); a communication path to connect between the first and the second communication means (Figure 5; col. 5, lines 50-57; col. 6, lines 50-59); the second communication means comprising: question data transmission means for transmitting questions data regarding changeable items in the software (select attributes to change) of the virtual creature and/or hardware holding a recording medium in which the software is stored to the first communication means that accesses via the communication path (Figure 5, col. 5, line 66- col. 6, line 15; col. 6, lines 31-39); and data processing means for conducting

the predetermined data processing in order to form the virtual creature and/or the hardware reflecting the order sender's answer to the question to be transmitted from the first communication means via the communication path (Figure 5, col. 6, lines 37-40).

Regarding claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30, 32-35, 37-40, 42-45, and 47-50, Barad discloses the changeable item is the specification on the action or motion (programmed to move in a particular manner) of the virtual creature and robotic device (col. 3, lines 63-67); changeable items are the design of the virtual creature or the hardware and robotic device (col. 5, lines 52-65, Figure 7, Figures 13-17; Figures 21-22); the data processing means analyzes the taste and/or the living environment of the order sender based on the order sender's answer to the question and conducts the data processing according to the analysis result (Figure 5, col. 6, lines 30-40; col. 6, lines 49-59); and the data processing means forms the image data of computer graphic image of the virtual creature and robotic device (representational image showing he personalized toy) and/or the hardware reflecting the order sender's answer to the question, and transmits the image data to the first communication means via the communication path (Figure 5; col. 6, lines 60-66)

Regarding claims 26, 31, 36, 41 and 46, Barad discloses a system, method, device, and computer program for purchasing or receiving an order of a robotic device (personalized toy...may include other types of components, such as electronic components housed within the toy and programming for such electronics....toy may be programmed to move in a particular manner, col. 3, lines 57-67) to act or move based on the predetermined program, comprising: first communication means provided on the

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order sender side (accessing a computer in 110 is performed by customer 60) of the robotic device (collecting orders, col. 5, lines 50-61, Figure 5); second communication means provided on the order receiving side of the robotic device (processing ordering, col. 5, lines 50-51; col. 6, lines 52-61, Figure 5); a communication path for connecting the first and the second communication means (Figure 5; col. 5, lines 50-57; col. 6, lines 50-59); the second communication means comprising: question data transmission means for transmitting questions data on changeable items (select attributes to change) of the robotic device to the first communication means that accessed via the communication path (Figure 5, col. 5, line 66- col. 6, line 15; col. 6, lines 31-39); and data processing means for conducting the predetermined data processing to construct the robotic device by reflecting the order sender's answer to the question to be transmitted from the first communication means via the communication path (Figure 5, col. 6, lines 37-40).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,636,994 to Tong discloses an interactive system computer controlled doll.

U.S. Patent No. 5,873,765 to Rifkin et al. discloses toys having internally powered mechanisms and particularly those capable of producing motion, sound or other action outputs.

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U.S. Patent No. 6,012,961 to Sharpe, III et al. discloses an electronic toy having a reprogrammable or recordable data storage device, whereby a user can selectively download program information into the data storage device to change the operating characteristics of the toy during use.

U.S. Patent No. 6,572,431 to Maa discloses interactive toy system wherein the actuation of a movable portion of the toy and the sound are controlled and coordinated by a multimedia computer.

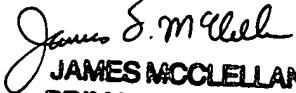
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
February 18, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER